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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/752,438	01/05/2004	Wolfgang Fitz	2960/118	3735
2101 7590 09/06/2007 BROMBERG & SUNSTEIN LLP 125 SUMMER STREET BOSTON, MA 02110-1618			EXAMINER STEWART, JASON-DENNIS NEILKEN	
			ART UNIT 3709	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/752,438

Applicant(s)

FITZ ET AL.

Examiner

Jason-Dennis Stewart

Art Unit

3709

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____  |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :29 March 2004,22 March 2004, 27 June 2005.

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Figs. 8A – 8C are missing from drawings. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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3. Claims 1-3, 8, 9, 11, 17, 19-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Fell 2003/0055501.
4. Re Claim 1, Fell teaches a superior surface 106, an inferior surface 104, and the superior and inferior surfaces match the shape of the femoral and tibial articular surfaces (paragraph 25).
5. Re Claim 2, Fell teaches providing a congruent bearing surface for the femoral condyle to bear against (paragraph 25).
6. Re Claim 3, Fell teaches an implant that effectively replaces worn articular material and may be thicker in places of cartilage wear (paragraphs 17, 54).
7. Re Claim 8, Fell teaches an implant made of CoCr (paragraph 14).
8. Re Claim 9, Fell teaches an implant comprising biologically active materials (paragraph 72).
9. Re Claim 11, Fell teaches an implant comprising a metal and a polymer (paragraph 15).
10. Re Claim 17, Fell teaches an implant that approximates the femoral surface (paragraph 25).
11. Re Claim 19, Fell teaches an implant being selected from a library of implants (paragraphs 25, 95).
12. Re Claim 20, Fell teaches an implant that is inserted via a 3cm to 5cm incision (paragraph 25).
13. Re Claim 21, Fell teaches an implant that is inserted via a 3cm to 5cm incision (paragraph 25).

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14. Re Claims 22-25, Fell teaches a patient returning to full knee extension and 120 degrees of flexion.

15. Re Claims 26, Fell teaches a congruent bearing surface for the femoral condyle (paragraph 25).

16. Re Claim 27, Fell teaches a condylar implant having a superior surface 106 that opposes the condyle of the femur and an inferior surface 104 that opposes the tibial surface (fig. 6). Fell further teaches that surfaces substantially match the femoral and tibial contact surfaces.

***Claim Rejections - 35 USC § 103***

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fell 2003/0055501. Fell teaches a device that is offered in multiple thicknesses (paragraph 25), but does not positively recite the claimed thickness percentages. It has been held that "The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages." **See MPEP 2144.05, Section II, in re Peterson**. It would have been obvious to one of ordinary skill in the art to modify the thickness in order to treat an individual patient.

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18. Claims 6,7, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fell et al. 2003/0055501 i.v., Fell et al. 2003/0060882.

19. *Re Claim 6*, Fell –501 teaches the invention as claimed and as discussed above. However, Fell –501 does not teach the following claimed limitation: an implant having a thickness of a cartilage defect plus a predefined offset value.

Fell teaches thickness and offset defined by a ratio (paragraph 28, fig. 3). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Fell –501 i.v., Fell –882 in order to restore normal joint alignment without requiring any bone resection or any means of bone fixation as taught by Fell –882.

20. *Re Claim 7*, Fell –501 teaches accommodating different conditions a variety of offsets (paragraph 56).

21. *Re Claim 10*, Fell –501 teaches a biologically active surface (paragraph 72).

22. Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fell et al. 2003/0055501 i.v., Fell 2003/0060884.

23. *Re Claim 12*, Fell –501 teaches the invention as claimed and as discussed above. Fell –501 does not teach the following claimed limitation: a structure for attachment.

Fell –884 teaches protrusions (522a, 522b).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Fell –005 i.v., Fell –884 in order to restore normal joint alignment without requiring any bone resection or any means of bone fixation as taught by Fell –884.

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24. Re Claim 13, Fell –501 teaches the invention as claimed and as discussed above. Fell –501 does not teach the following claimed limitation: a plurality of structures.

Fell –884 teaches protrusions (522a, 522b).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Fell –005 i.v., Fell –884 in order to restore normal joint alignment without requiring any bone resection or any means of bone fixation as taught by Fell –884.

25. Re Claim 14, Fell –501 teaches the invention as claimed and as discussed above. Fell –501 does not teach the following claimed limitation: structure orientation.

Fell –884 teaches a symmetrical structure orientation (fig. 8).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Fell –005 i.v., Fell –884 in order to restore normal joint alignment without requiring any bone resection or any means of bone fixation as taught by Fell –884.

26. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fell et al. 2003/0055501 i.v., Andriacchi et al. 2004/0098132. Fell teaches the invention as claimed and as discussed above. However, Fell does not teach the following claimed limitation: an implant covering a portion of a patellar surface of the femur.

Andriacchi teaches an implant covering a portion of a patellar surface of the femur (fig. 1).



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It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Fell i.v., Andriacchi in order to accommodate knee flexion angles of more than 130 degrees as taught by Andriacchi (paragraph 7).

27. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fell et al. 2003/0055501 i.v., Fell et al. 6,206,927. Fell –501 teaches the invention as claimed and as discussed above. However Fell –501 does not teach the following claimed limitation: the slope between the superior and inferior surfaces being positive, negative, or null.

Fell –927 teaches positive slope of the superior surface relative to the inferior surface (fig. 7).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Fell –501 i.v., Fell –927 in order to exert a restoring force on the free-floating device as taught by Fell –501 (abstract).

28. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fell et al. 2003/0055501 i.v., Repicci 2002/0133230. Fell teaches the invention as claimed and as discussed above. However, Fell does not teach the following claimed limitation: a condyle having a chamfer cut.

Repicci teaches a chamfer cut 112 in the femoral condyle (fig. 7).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Fell i.v., Repicci in order to allow some slippage and simultaneously correct the slippage as taught by Repicci (paragraph 6).

***Conclusion***

29. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure, as per the Notice of Reference Cited.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason-Dennis Stewart whose telephone number is (571)270-3080. The examiner can normally be reached on M-F (alt Fridays off) 7:30-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ehud Gartenberg can be reached on (571)272-4828. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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JS

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09/04/07

*Kim S. Smith*  
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PRIMARY EXAMINER

9/4/07